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10/579,034	09/18/2006	Masaki Ninomiya	R2184.0494/P494	4395
24998 7590 11/23/2010 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
CHU, KIM KWOK				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,034

Applicant(s)

NINOMIYA ET AL.

Examiner

Kim-Kwok CHU

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 9/17/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7, 13, 14, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7, 13, 14, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Improper Dependent Claim

1. Claims 14 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claim(s) to place the claims in proper dependent form, or rewrite the claim(s) in independent form. In this case, Claim 14 depends on a cancelled Claim 9 and Claim 21 depends on a cancelled Claim 16.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-7, 13, 14, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 5, last 5 lines, the amended step of recording indicator information in a count zone is indefinite because it has no relationship with the claimed optimum recording power determining step. In other words, the claimed recoded indicator information and the claimed location of the count zone are not steps of determining an optimum recording power.

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Similarly, in each of Claims 13 and 20, last paragraph, the amended feature of recording indicator information in a count zone is indefinite because it has nothing to do with the claimed operation of determining optimum recording power. That is, it is not clear how the claimed recoded indicator information and the claimed location of the count zone can be used to determine an optimum recording power.

The claims not specifically mentioned above are indefinite based upon their dependence on an indefinite claim.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 5-7, 13 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Narumi et al. (U.S. Patent 7,376,058).

6. Narumi teaches a method for determining an optimum recording power having all of the steps as recited in claims 5-

7. For example, Narumi teaches the following:

Regarding Claim 5, the recording method which determines an optimum recording power value by performing test writing on a test zone 426/436 (Fig. 4) of a recording medium 400 and records information on the recording medium with the determine optimum recording power (Fig. 4; column 13, lines 46-53), wherein the recording medium 400 is a multilayer recording medium having a plurality of recording layers 420/430 within one recording surface (one recording surface having two recording layers); the test zone is formed on each recording layer (Fig. 4; test zone 426 for layer 420; test zone 436 for layer 430); the test zones in different recording layers are positioned in a same recording surface area (Fig. 4; same data recording format)

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and when information (test/data) is to be recorded on a target recording layer 430 that is second or further from a light source (layer 430 is the second layer further away from the incident light beam), information (such as test data) is recorded on the test zone 428 (test writing on first layer 420), which is an upper recording layer closer to the light source than the target recording layer 430 and is positioned in the same recording surface area 436/426 as that of the test zone in the target recording layer before the test writing is performed on the test zone in the target recording layer before the test writing is performed on the test zone 436 in the target recording layer 430 (Fig. 4; updating test zone 436 after data is recorded in second layer 430); and wherein, after information (test data) is recorded on the upper recording layer 420 closer to the light source than the target recording layer 430 before the test writing on the target recording layer 430, indicator information (such as addresses/header or data management information) indicating a zone 436/426 where the information recording has been performed is recorded in a count zone (such as a lead-in area or ROM 432/422) of the recording medium, and wherein the location of the count zone 132/122 is different than the location of the zone 436/426 where the information (test data) recording has been performed.

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Regarding Claim 6, the information recording on the upper recording layer 420 (Fig. 4) is performed, before the test writing on the target recording layer 436, only on a portion 426, which portion is used to perform the test writing once, of the test zone in the upper recording layer 420 (Fig. 4; test writing is performed on layer 420 first); and the subsequent test writing for the target recording layer 430 is performed on a portion 426 of the test zone in the target recording layer 420 (Fig. 4; updating test writing), and wherein the portion of the test zone 426 in the upper recording layer 420 is positioned in a same recording surface area as the portion of the test zone in the target recording layer (Fig. 4; 426 and 436 are same locations).

Regarding Claim 7, the information recording on the upper recording layer 420 is performed, before the test writing on the target recording layer 430, on an entire area of the test zone in the upper recording layer (Fig. 4; test writing is performed on layer 420 first).

7. Apparatus claims 13 and 14 are drawn to the apparatus corresponding to the method of using same as claimed in claims 5-7. Therefore apparatus claims 13 and 14 correspond to method claims 5-7, and are rejected for the same reasons of anticipation as used above.

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 20 and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Narumi et al. (U.S. Patent 7,376,058) in view of Adachi et al. (U.S. Patent 7,027,370).

Narumi teaches an apparatus for determining an optimum recording power value very similar to that of the present invention. However, Narumi does not teach the following:

Regarding Claim 20, a non-transitory computer-readable storage medium having a program embodied therein for causing a computer, which makes a recording apparatus determine an optimum recording power value.

Adachi teaches the following: a non-transitory computer-readable storage medium having a program embodied therein for causing a computer, which makes a recording apparatus determine an optimum recording power value (Fig. 1; column 14, lines 32-43).

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An optimum laser power calibration operation such as Narumi's is controlled by a program/routine written inside a processing unit 901 (Fig. 9). However, when there is a need to alter the power calibration under new operation modes, the embedded program/routine has to be rewritten. In this case, it would have been obvious to one of ordinary skill in the art to replace Narumi's internal program/routine with Adachi's program written in a computer-readable storage medium, because Adachi's program stored in a storage medium is transferrable and can be updated/modified easily.

10. ***Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/
Examiner AU2627
November 17, 2010
(571) 272-7585

/HOA T NGUYEN/

Supervisory Patent Examiner, Art Unit 2627